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EXAMINER

PIAZZA, GLADYS J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 04/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,842

Applicant(s)

BIAGIOTTI, GUGLIELMO

Examiner

Gladys J. Piazza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 21-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12, 14 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 13 and 15-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 21-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups II and III, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Objections

2. Claims 8, 9, 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 8, 9 20 have not been further treated on the merits.
3. Claims 8, 9, 13, 16, 18, 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8, 9, 13, 16, 18, 20 have not been further treated on the merits.
4. It is noted that claims 15, 17, 19, are dependent on improper multiple dependent claims and are also not further treated on the merits.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 7 recites the limitation "said third set of protuberances" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to -a third set of protuberances--.

8. Claim 12 recites the limitation "the three layers" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first second and third layers--.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 3, 5, 6, 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz '248 (EP 0408248) in view of Schultz '162 (US Patent No. 4,320,162).

Schultz '248 discloses a method of producing an embossed sheet material by embossing a first layer of web material previously embossed with a background pattern (column 4, lines 10-14 and lines 43-45 pre-embossing the webs with a fine pattern) to form a second set of protuberances partially superimposed on the first set of protuberances and defining an ornamental motif with major dimensions and minor density with respect to the background pattern (the pre-embossed web is further embossed column 4, lines 23-26; column 5, lines 20-25 where the pre-embossing

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pattern is more shallow and finer; column 6, lines 31-32), coupling a second layer to the first layer with glue (column 4, lines 38-43).

Schultz '248 does not specifically disclose the manner in applying the glue to the webs and only recites that the adhesive can be applied in a manner known in the art (column 4, lines 38-43). Schultz '162 discloses a known method of embossing two layers of material joined together where glue is conventionally applied to a second set of protuberances of major dimensions and minor density with respect to a first set of protuberances and the first set is substantially free of glue (column 2, lines 65-68; column 3, lines 54-56; adhesive is applied to the minor density and deeper embossments and not to the major density, finer, shallow embossments) in order to provide improved softness, water retention, bulk and aesthetics (column 3, lines 10-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of embossing and joining layers as shown by Schultz '248 by applying glue only to the second set of protuberances in order to provide improved characteristics to the web as shown by Schultz '162.

As to claim 2, Schultz '248 discloses embossing in line the background pattern before the embossing of the second set of protuberances or the ornamental motif (see figures and description). As to claim 3, both Schultz '248 and 162 show embossing a second layer of web material with a third set of protuberances that has a major dimension and a minor density with respect to the first set of background pattern (the bonded web also is embossed with a less fine and deeper embossment pattern than the background or pre embossing pattern Schultz '248: column 4, lines 23-25). As to claim

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5, Schultz '248 discloses running the first layer around a first pressure roller (28) interacting with a first (30) and second embossing cylinders (36) that have first and second points where the second points have larger dimensions and lower density than the first set (see figure 2). As to claim 6, Schultz '248 shows in figure 2, joining the first and second layers (12, 20) between the first pressure roller (28) and the first embossing cylinder (30). However, Schultz '248 also discloses that as an alternative, only one ply may be pre-embossed and any plies that are not pre-embossed can join at a latter nip (column 2, lines 26-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to joint the first and second layers (12, 20) between the first pressure roller (28) and the second embossing cylinder (36) by introducing the second layer (20) at this nip (34) as a disclosed alternative to the method shown in figure 2 where the second layer (20) is introduced at a previous nip (26). As to claim 7, the second embossing cylinder (36) interacts with a second pressure roller (40) to generate the third set of protuberances on the second layer (see figure 2). As to claim 10, the second layer (20) is run around the first pressure roller (28) downstream of the area that the first layer (12) is embossed between the first embossing cylinder (30) and the first pressure roller (28), and embossing the second layer (20) on the first layer (12) between the first pressure roller (28) and the second embossing cylinder (36) (see figure 2). As to claim 14, both Schultz '248 and 162 show the second web having a pre-embossed background pattern (Schultz '248: column 4, lines 12-14).

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11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz '248 in view of Schultz '162 as applied to claim 3 above, and further in view of Laurent et al. '168 (US Patent No. 5,686,168).

Schultz '248 discloses embossing both the first and second webs with second and third sets of protuberances simultaneously with the same density (the webs are embossed together between the same rolls column 4, lines 23-25). Since both sets of protuberances are embossed between the same rolls, then the protuberances would be inserted inside one another. Optionally, Laurent '168 further shows it is known in the art to insert protuberances of two webs inside one another (see figures 5 and 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of forming a web as shown by Schultz '248 in view of Schultz '162 by inserting the protuberances of the two layers as would occur in Schultz '248 and optionally further exemplified by Laurent '168.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz '248 in view of Schultz '162 as applied to claim 10 above, and further in view of Barnholtz (WO 97/44528) and Laurent '223 (US Patent No. 5,736,223, based on WO/95/02089).

Schultz '248 discloses arranging a second pressure roller (40) around the second embossing cylinder (36) (see figure 2). Schultz '248 also discloses that more than two plies can be used for the multi-ply web (column 3, lines 25-26). Schultz '248 further discloses that plies can be introduced without pre-embossing into the nips downstream (column 2, lines 31-34). It is further known in the art to join a third layer at the last

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joining nip in the process of embossing and joining layers. For example, Barnholtz discloses joining a third web that does not include pre-embossing to two embossed layers (third web 42B; page 14 and figure 2B). Also, Laurent '223 discloses an example where a third web is joined to two embossed layers without pre-embossing the third web (web 3, see figures 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a multi-ply web as shown in Schultz '248 in view of Schultz '162 by adding a third web between the second pressure roller and the second embossing cylinder in order to join and emboss a third web to the two layers since Schultz '248 discloses joining multiple webs together and bringing in webs at downstream nips in order to provide webs without pre-embossing and as further exemplified by Barnholtz and Laurent '223 that it is known in the art to add third webs in such a process.

As to claim 12, Schultz '248 only discloses that the adhesive application is of conventional, known practices (column 4, lines 38-42). Laurent '223 discloses it is known in the art to apply adhesive from a single applying unit to one web so that the adhesive permeates through the middle ply. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method as shown in Schultz '248 in view of Schultz '162 by applying adhesive so that it migrates through the first layer toward the second layer in order to reduce the number of glue units as shown by Laurent '223.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J. Piazza whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Gladys Piazza
April 17, 2002


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700